

REMARKS

I. Summary of the Office Action and this Reply

Claims 1-12 are pending. The Examiner has rejected claims 1-12 under 35 U.S.C. § 103(a), asserting that such claims are obvious over U.S. Patent No. 6,084,638 to Hare et al. ("Hare"). In this Reply, claims 1, 9, 10 and 11 are amended for clarity, without a change in claim scope. New claims 13-15 are added. No new matter is added.

Four sheets of formal drawings are submitted herewith.

II. Discussion of the Cited Art

Hare discloses a system that permits the user interface of a PC to be extended to the location of a remote television (TV) receiver such that video and audio signals generated by the PC may be viewed and heard on the remote TV. Abstract. By way of example, a PC's video display signal may be converted at the PC from a PC scan format to a conventional television signal format (e.g. NTSC format). Alternatively, the conversion may occur at the TV receiver's location such that the PC video display signal is transmitted in PC scan format to the TV receiver location and then converted to a TV scan format for viewing on the TV receiver. The PC video display signal may then be transmitted from the PC location to the TV receiver location as a modulated radio frequency or microwave signal over the air. Col. 4, lines 5-41.

Hare thus purports to disclose a system by which audio and video displays of a PC are reproduced at a remotely located television.

III. Response to 103 Rejections

A section 103 rejection is proper only if all claim limitations are taught or suggested by the cited art. Moreover, even if all elements are found in the cited art, there still must be motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to make the proposed modification to, or combination of, the cited art. MPEP §2143.

Claims 1 and 9

The Examiner has rejected claims 1 and 9 under 35 U.S.C. § 103(a) in view of Hare.

Independent claim 1 recites "a text-to-speech converter . . . converting . . . machine-readable text code to an audible speech signal and outputting said audible speech signal at said output."

The Examiner acknowledges in paragraph 3 of the Action that "Hare does not explicitly teach a text-to-speech converter included in the PC." Applicants agree. Further, Hare does not implicitly or otherwise teach or suggest any use of a text-to-speech converter. Accordingly, not all claim limitations are taught or suggested by the cited art. A prima facie case of obviousness has not been established. Accordingly, reconsideration and withdrawal of the rejection are requested respectfully.

Although U.S. Patent No. 5,555,343 to Luther is not cited in the rejection, the Examiner has referenced Luther in paragraph 3 of the Action, asserting that Luther teaches a text to speech converter in a PC. Regardless of whether Luther teaches a text to speech converter in a PC, there is absolutely no motivation, in the reference or

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otherwise to make the proposed modification or combination. More specifically, the Examiner has not cited any motivation in Hare (or Luther) for modifying the reference to arrive at the claimed invention. The U.S. Court of Appeals for the Federal Circuit has considered the issue of finding motivation and stated that a finding of motivation "must be based on objective evidence of record" and that:

[an] Examiner's conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang-Su Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

The Examiner has merely asserted on page 2 of the Action that:

it would have been obvious to one of ordinary skill in the art at a time of the invention to convert text to speech, where text is obtained from different source so as to provide speech to a person to on the able read text with better understanding [SIC].

Accordingly, the Examiner's asserted motivation is merely a conclusory statement without any basis in the evidence of record. The Federal Circuit has clarified that conclusory statements asserting motivation that are based on "common knowledge and common sense" are not sufficient to fulfill the obligation to develop an evidentiary basis for its findings. *Id.* There is no objective evidence of record, particularly in Hare or Luther, providing the asserted motivation.

Further, the Examiner's assertion that "it would have been obvious to convert text to speech," is not the relevant issue. What is claimed is "a text-to-speech converter . . . converting said machine-readable text code to an audible speech signal and outputting said audible speech signal at said output . . . and a transmitter . . . transmitting the output of said text-to-speech converter as a transmitted audio signal." This is neither

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taught nor suggested by Hare and/or Luther, and the Examiner has not asserted otherwise.

Further still, it cannot be obvious to modify Hare to provide the claimed system because doing so would destroy the purpose of the Hare system and/or render it unsatisfactory for its intended purpose. More specifically, the essence of the Hare system is to reproduce at a remote location (e.g. on a TV in one room) video and/or audio that would normally be produced at a PC (e.g. in a different room). Accordingly, if text that would be displayed on the PC were converted to an audio signal by a text to speech converter, and that audio signal were transmitted to the TV and reproduced on the TV in the TV's room, then the text produced at the PC would not be reproduced at the remote TV. This is directly contrary to the teachings of Hare, and thus destroys the intended purpose of the Hare system and/or renders it unsatisfactory for its intended purpose. Therefore, there cannot be motivation to make the modification/combination proposed by the Examiner.

Independent claim 9 is directed to a method including similar recitations, and therefore is likewise patentable for the reasons set forth above for claim 1.

For at least these reasons, reconsideration and withdrawal of the rejection of claims 1 and 9 are requested respectfully.

Claims 2-8 and 10-12

Claims 2-8 and 10-12 depend from claims 1 and 9, respectively, and are likewise patentable.

In addition, claim 2 recites that "the transmitted audio signal comprises an FM signal in the public FM band." Contrary to the Examiner's assertion in paragraph 3 of the Action, Hare provides absolutely no such disclosure, particularly at the portion cited by the Examiner, namely, col. 8, lines 30-48. Instead, the cited portion of Hare relates to use of a frequency agile modulator (FAM) for locating available/unused frequencies on a cable television cable, and to modulate signals onto one or more of those otherwise unused channels. The FAM is part of the head end unit 50 and thus is on the receiving end of the wireless transmission (see Fig. 1b); the FAM is directly connected to the cable television cable. The FAM has absolutely no relation to broadcasting/transmission of an FM signal in the public FM band.

Claim 4 recites that the receiver comprises an FM radio. This is neither taught nor suggested by Hare. Hare discloses only use of a TV as a receiver. Claim 4 implicitly requires that the transmitter transmits an FM signal in the conventional FM radio band, namely, approximately 88-108 MHz. This also is neither taught nor suggested by Hare. It is again emphasized that Hare, col. 8, lines 38-48, has absolutely no relationship to a conventional FM radio, such as that found in a car stereo system. See specification, page 2, lines 13-14; page 4, lines 2-3.

New claims 13-15

New claims 13-15 are believed patentable for reasons similar to those set forth above for claims 1, 4 and 9. Allowance of claims 13-15 is requested respectfully.

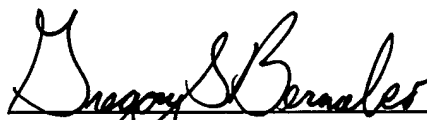
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CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe claims 1-15 to be patentable and the application in condition for allowance, and request respectfully issuance of a Notice of Allowance. If any issues remain, the undersigned requests a telephone interview prior to the issuance of an action.

Respectfully submitted,

Date: March 21, 2005

A handwritten signature in black ink, appearing to read "Gregory S. Bernabeo". The signature is fluid and cursive, with the first name "Gregory" and last name "Bernabeo" clearly distinguishable.

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